



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YASUhide TACHI et al

Serial No. 024,111

Group: 125

Filed: March 26, 1979

Examiner: Roberts

For: NOVEL HYDROCORTISONE DERIVATIVE

RESPONSE TO PAPER NO. 14

Honorable Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

The following remarks are in response to the
Examiner's office action dated July 3, 1980.

The sole remaining rejection, that of claim 1 under
35 USC 103 over Ercoli et al in combination with Elks et al (2),
is respectfully traversed. It is submitted that the issue of
patentability posed by these references has been reduced to the
issue of whether or not the ten-fold superiority in therapeutic
effectiveness of applicants' claimed compound over the closest
prior art compound, i.e. the 17, 21-diester of hydrocortisone,
disclosed by Ercoli et al at col. 4, line 49, would have been
expected from a reading of the references. Applicants readily
concede that if the superiority would have been expected from a
reading of the references then the showing represented by the pre-
viously submitted declaration would not serve to overcome the prima
facie case of obviousness. However, applicants submit that the
ten-fold superiority possessed by their compound which they have
proven would not have been expected from a reading of the references
of record.

Before proceeding to what the undersigned regards as
the real issue of record, a few comments are in order with regard

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